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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/393,579 09/09/99 KECZER S IR98-7410

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ATTN LOIS K RUSZALA ESQ
DADE BEHRING INC LEGAL DEPARTMENT
1717 DEERFIELD ROAD
BOX 778
DEERFIELD IL 60014-0778

EXAMINER

CELSA, B

ART UNIT

PAPER NUMBER

1627

DATE MAILED:

12/13/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

file copy

Office Action Summary

Application No.
09/393,579

Applicant(s)

De Keczer et al.

Examiner

Bennett Celsa

Group Art Unit

1627



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-56 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-56 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claims 1-56 are currently pending.

Election/Restriction

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, drawn to a protected alkylating reagent, classified in class 562, subclass 490.
 - II. Claims 13, 17, 18 and 31, drawn to a compositions for use in a method of coupling (e.g. forming a conjugate), classified in class 424, subclass 94.5.
 - III. Claims 14-16, 19-30, 32-44 and 46, drawn to compositions (e.g. kits) for use in a method of determining homocysteine, classified in class 436, subclass 518.
 - IV. Claim 45, drawn to a method of preparing a phosphorylated haloketone, classified in class 568, subclass 303.
 - V.. Claims 47-49, drawn to a method for releasing an alkylating reagent into an aqueous medium, classified in class 585, subclass 370.
 - VI. Claim 50 is drawn to a method of alkylating a mercaptan, classified in class 562, subclass 557.
 - VII.. Claims 51-56, drawn to enol ester, classified in class 568, subclass 850.

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2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and VII are drawn to compounds of differing scope, and structure which possess different physicochemical and biological properties and are capable of separate manufacture and/or use and require different and separately burdensome manual and/or computer structure and bibliographic searches. A reference to a compound of Group I will not necessarily serve to anticipate and/or render obvious a compound within the scope of Group VII and vice versa and thus groups I and VII are drawn to independent and/or patentably distinct inventions.

3. Inventions (I or VII) and (II or III or IV or V or VI) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product : such as in any one of the processes of Groups II-VI. Additionally, the process for using the product (e.g. Group II-VI) as claimed can be practiced with another materially different alkylating agent product (e.g. the use of a Group I instead of a Group VII compound; as well as the use of a totally different type of alkylating agent.

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4. Inventions II-VI are drawn to independent and/or patentably distinct methods since each of these groups are separately drawn to methods which have different objectives, utilize different reactants, utilize different chemical reaction conditions and obtain a different final product(s).

Additionally, these methods would necessarily require different and separately burdensome manual and/or computer searches.

5. Because these inventions are distinct for the reasons given above and:

- a. have acquired a separate status in the art as shown by their different classification;
- b. require different and separately burdensome manual/computer searches; and
- c. these groups have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

ELECTION OF SPECIES (FOR GROUPS I-VII ABOVE):

6. The claims are drawn to a plurality of disclosed patentably distinct alkylating compound species comprising different structures, which are capable of separate manufacture and/or use and which require different and separately burdensome manual and/or computer searches.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. A COMPOUND STRUCTURE CORRESPONDING TO THE ELECTED COMPOUND MUST BE PROVIDED FOR PURPOSES OF SEARCH.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

General information regarding further correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat (art unit 1627), can be reached at (703)308-0570.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Bennett Celsa (art unit 1627)

December 12, 2000

**BENNETT CELSA
PRIMARY EXAMINER**

